

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 40

Serial Number: 07/411576
Filing Date: 09/22/89
Appellant(s): Anthony Maglica

John D. McConaghy
For Appellant

MAILED

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EXAMINER'S ANSWER

GROUP 2900

This is in response to appellant's brief on appeal filed 09/10/96.

(1) *Status of the claim.*

The statement of the status of the claim contained in the brief is correct.

(2) *Status of Amendments After Final.*

The amendments after final rejection filed on 02/27/96, 08/19/96, and 09/05/96 have been entered.

(3) *Summary of invention.*

The claimed design is directed to a flashlight.

(4) *Issues.*

The appellant's statement of the issues in the brief is substantially correct. In addition to the issue of whether applicant's claimed design is entitled to the benefit of priority under 35 U.S.C. 120 which would then preclude the outstanding rejection of the claim under 35

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U.S.C. 103(a), the issue of whether new matter under 35 U.S.C. 112, first paragraph exists in view of the most recently submitted proposed drawings received 09/05/96 remains outstanding.

(5) *Grouping of claims.*

The grouping of claims is not applicable in a design patent application since there is only a single claim.

(6) *Claim appealed.*

The copy of the appealed claim contained in the Appendix to the brief is correct.

(7) *Prior Art of record.*

The following is a listing of the prior art of record relied upon in the rejection of the claim under appeal.

4658336	Maglica	04/14/87
4750095	Huang	06/07/88

(8) *New prior art.*

No new prior art has been applied in this examiner's answer.

(9) *Grounds of rejection.*

The following grounds of rejection are applicable to the appealed claim:

Rejection under 35 U.S.C. 103(a)

The claim is rejected under 35 U.S.C. § 103(a) as being unpatentable over Maglica (4,658,336) in view of Huang. Although the invention is not identically disclosed or described as set forth in Section 102 of the statute, if the differences between the subject

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matter sought to be patented, and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary ability in the art to which said subject matter pertains, the invention is not patentable.

The Maglica patent, Fig.8, shows a flashlight of essentially the same appearance as the claimed design except for the rounded head. The Huang patent shows a rounded head similar to that of the claimed design.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Maglica, Fig.8, flashlight by providing a rounded head as shown by the Huang flashlight to meet the overall appearance of the claimed design.

This modification of the basic reference in light of the secondary prior art is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other. *In re Rosen*, 213 USPQ 347 (CCPA 1982); *In re Carter*, 213 USPQ 625 (CCPA 1982), and *In re Glavas*, 109 USPQ 50 (CCPA 1956). Further, it is noted that case law has held that one skilled in the art is charged with knowledge of the related art; therefore, the combination of old elements, herein, would have been well within the level of ordinary skill. *In re Antle*, 170 USPQ 285 (CCPA 1961) and *In re Nalbandian*, 211 USPQ 782 (CCPA 1982).

Rejection of the claim under 35 U.S.C. 112, first paragraph

The claim is rejected under 35 U.S.C. 112, first paragraph for new matter. The proposed additional illustration submitted 09/05/96 has been entered, however said

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amendment introduces new matter (35 U.S.C. § 132, 37 C.F.R. § 1.118). Due to the differences between the original and new drawings, applicant's disclosure fails to comply with the description requirement of 35 U.S.C. § 112, first paragraph. Accordingly, the claim remains FINALLY rejected in that the disclosure does not satisfy the description requirement of 35 U.S.C. § 112, first paragraph. (In re Kaslow, 217 USPQ 1089 and In re Rasmussen, 211 USPQ 323.) The new matter is described as follows:

- a) The smooth portion of the barrel between the threaded end (bulb end) and the knurled barrel is proportionally longer than shown in the original formal and the original mechanical drawings.
- b) In Fig.3, the distance between the outermost concentric circle and the next concentric circle toward the inside is proportionally wider than in the original formal or the original mechanical drawings. Although applicant asserts that this is for consistency with the proportions of the flashlight head to the barrel and to the threaded end (shown in new Figs.1 and 2), the flashlight head in the new drawing is proportionally wider than in the original disclosure.

(10) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

(11) *Response to argument.*

Rejection of the claim under 35 U.S.C. 103(a)

Appellant maintains his position that Figs. 2, 3 and 8 of the original parent application show a curved flashlight head as confirmed by declarations submitted previously. However, the examiner maintains the position that the figure views have been considered in their

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entirety and that Figs.1-3 of the original parent application show a flashlight head with a distinct change in plane. In Figs.1-3, a planar surface meets another planar surface at a distinct intersection on the surface of the flashlight head. Fig.8, the cut-away view, does not show the area in question. In no instance has the examiner based the decision to deny the benefit of priority on the single original parent application Fig.1 view.

Appellant asserts that the declarations submitted by Martin J. Siegel and Jack B. Miller confirm the curved contour of the flashlight head. However, the examiner maintains the position that what is visually shown in the 06/648,032 ('032) original parent application must be the basis of determining the benefit of priority. The original parent application shows a flashlight head with a distinct change in plane, a characteristic that is consistent among Figs.1-3. (Note that since Figs.4-7 in the original parent application show specific details of the functional portions of the flashlight, they are not mentioned as readily as the other figure views.) As the Board affirmed in the decision of 06/23/93, the junction between the cylindrical and tapered portions is

nevertheless sharp enough when viewed from the normal size of the drawings to conclude that it was not inconsistent or a draftsman's error to add the parting line Bd1 in the perspective view of Figure 1 of the drawings as originally filed in the '032 utility application. (See Board decision, p.17).

Appellant refers to Exhibits A-C attached to the response submitted 08/23/93 to further establish the curved flashlight head shape. The declarations, drawings and testimony have been considered, but do not overcome the denial of the benefit of priority of the filing date of

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the original parent application, '032. The description of the process by which the different sets of drawings were created does not overcome a straightforward comparison between the original drawings in the parent application and the drawings submitted in the instant application.

Appellant describes after final amendments submitted 02/27/96 and 09/05/96. These amendments were responded to with advisory actions mailed 03/19/96 and 11/12/96, respectively.

Appellant also refers to his own previously submitted declarations on 08/09/91 and 12/17/91. Although appellant asserts that the contour line describing the change in plane in the Fig.1 view is a mistake, and thus confirms that Figs.2 and 3 show a curved head, the examiner's position remains that Figs.2 and 3 show a flashlight head with a change in plane consistent with the contour line in Fig.1. Since it remains the examiner's position that the contour line is supported by Figs.2 and 3, the "choice" between a flashlight head with a distinct change in plane or a flashlight head with a curved head does not exist. Because the flashlight head shown in the drawing of the instant application does not show the distinct change in plane as described by a contour line, the benefit of priority of the parent utility application '032 is denied.

Rejection of the claim under 35 U.S.C. 112, first paragraph

The most recent proposed drawing corrections were submitted on 09/05/96. An advisory action in response was mailed on 11/12/96. The basis of the rejection is described

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under heading (11) of this examiner's answer. The rejection under 35 U.S.C. 112, first paragraph remains outstanding.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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